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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/825,493	04/15/2004	Todd Fries	1735.ALA100-FOR	8565
26308 7590 12/05/2007 RYAN KROMHOLZ & MANION, S.C. POST OFFICE BOX 26618 MILWAUKEE, WI 53226			EXAMINER MCCLELLAND, KIMBERLY KEIL	
			ART UNIT 1791	PAPER NUMBER
			MAIL DATE 12/05/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/825,493

Applicant(s)

FRIES ET AL.

Examiner

Kimberly K. McClelland

Art Unit

1791

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 September 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 7-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 September 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>9/27/07</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/27/07 has been entered.

### ***Double Patenting***

2. The double patenting rejections of claims 1-6 over Application No. 11/527/293 is maintained. Applicant's preference to hold the rejection in abeyance is acknowledged. The rejection is maintained until appropriate action is taken.

### ***Response to Amendment***

3. As indicated in the previous office action dated 6/26/07 on form PTO-326, the current amendments to the drawings (amendment received 3/29/07 and a duplicate amendment received 9/27/07) have been entered.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over PCT International Publication No. WO88/01247 to Aguero in view of U.S. Patent No.

4,602,976 to Fukuda et al.

6. With respect to claim 1, Aguero discloses a cable marking apparatus, including a label roller assembly for supplying labels to said apparatus (column 4, lines 9-11); a rotatable puck mechanism (38), said puck mechanism having an interrupted circumferential surface (i.e. gap between 38a and 38b; See Figure 7); means for rotating said puck mechanism (page 1, line 18); means for transporting at least one of said labels toward said an interruption in said puck mechanism circumferential surface (36; See Figures 9-10). Aguero does not specifically disclose means for transporting said peripheral surface of said elongate article through said interruption in of said puck member circumferential surface.

7. Fukuda et al. discloses a binding machine, including means for transporting said peripheral surface of said elongate article through said interruption in of said puck member circumferential surface (23; See Figures 1-2). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the elongate article transporting means taught by Fukuda et al. with the apparatus of Aguero. The motivation would have been to effectively transport the article and prevent it from rotation during labeling (column 4, lines 30-35). It is well settled that it is not

"invention" to broadly provide a mechanical or automatic means to replace manual activity which has accomplished the same result. In re Venner, 120 USPQ 192.

8. As to claim 2, Aguero does not specifically disclose means for transporting said peripheral surface of said elongate object through said interruption in the puck member.

9. Fukuda et al. discloses a binding machine, including means for transporting said elongated article comprises a gripping mechanism (36), said gripping mechanism arranged to receive one of said elongate articles (15) and guide said of one said elongate articles through said interruption in said rotatable puck mechanism circumferential surface (See Figures 1-2). Fukuda et al. does not describe the driving means for driving said gripping mechanism, but it is inherent the gripping means (36) of Fukuda et al. would include driving means in order to open and close the chucking arm and move the article by "suitable means" (column 4, lines 1-5). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the elongate article transporting means taught by Fukuda et al. with the apparatus of Aguero. The motivation would have been to effectively transport the article and prevent it from rotation during labeling (column 4, lines 30-35). It is well settled that it is not "invention" to broadly provide a mechanical or automatic means to replace manual activity which has accomplished the same result. In re Venner, 120 USPQ 192.

10. As to claim 3, Aguero discloses at least one label sensor device (page 5, line 36-page 6, line 5).

11. As to claim 4, Aguero discloses a label roller assembly for supplying labels to said apparatus (column 4, lines 9-11); at least one gripper element for grasping and

moving said elongate article (59); means for driving said gripper element (62); a rotatable puck mechanism(38), said puck mechanism having an interrupted circumferential surface (i.e. gap between 38a and 38b; See Figure 7) for receiving said elongate object (50); and means for rotating said puck mechanism (page 1, line 18; See Figures 9 and 10). However, Agüero does not specifically disclose said at least one gripper element being movable between a first position and a second position, said elongate article passing through an interruption in said puck mechanism circumferential surface when said gripper element moves from said first position to said second position.

12. Fukuda et al. discloses a binding machine, including at least one gripper element (36) for grasping and moving said elongate article, and said at least one gripper element (36) being movable between a first position and a second position, said elongate article passing through an interruption in said puck mechanism circumferential surface when said gripper element moves from said first position to said second position (See Figures 1-2). Fukuda et al. does not describe the driving means for driving said gripping mechanism, but it is inherent the gripping means (36) of Fukuda et al. would include driving means in order to open and close the chucking arm and move the article by "suitable means" (column 4, lines 1-5). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the elongate article transporting means taught by Fukuda et al. with the apparatus of Agüero. The motivation would have been to effectively transport the article and prevent it from rotation during labeling (column 4, lines 30-35). It is well settled that it is not "invention"

to broadly provide a mechanical or automatic means to replace manual activity which has accomplished the same result. In re Venner, 120 USPQ 192.

13. Claims 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over PCT International Publication No. WO88/01247 to Aguero in view of U.S. Patent No. 4,602,976 to Fukuda et al. and U.S. Patent No. 6,350,070 to Tasma.

14. With respect to claim 5, Aguero discloses a cable marking apparatus, including a label roller assembly for supplying said labels and adhered backing strip to said apparatus (column 4, lines 9-11); label guide means for moving said labels through said apparatus (36); a label stripping assembly for removing said labels from said backing strip (31); a puck assembly (38), said puck assembly including a puck member having an interrupted circumferential surface (i.e. gap between 38a and 38b; See Figure 7). However, Aguero does not disclose gripper assembly for grasping and moving an elongate object through an interruption in said puck mechanism circumferential surface or a take up roll for receiving said backing strip.

15. Fukuda et al. discloses a binding machine, including gripper assembly for grasping and moving an elongate object through an interruption in said puck mechanism circumferential surface (23; See Figures 1-2). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the elongate article transporting means taught by Fukuda et al. with the apparatus of Aguero. The motivation would have been to effectively transport the article and prevent it from rotation during labeling (column 4, lines 30-35). It is well settled that it is not

"invention" to broadly provide a mechanical or automatic means to replace manual activity which has accomplished the same result. In re Venner, 120 USPQ 192.

16. Tasma discloses a label applicator, including a take up roll for receiving said backing strip (column 3, lines 41-47). It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the take-up spool taught by Tasma for the cutting edge of the cable marking apparatus disclosed by Aguero. The motivation would have been to ease the disposal of the waste backing.

17. As to claim 6, Aguero disclose at least a portion of the interruption (i.e. gap between 38a and 38b; See Figure 7) in said puck member circumferential surface is covered by a spring loaded (62) entrance door (56; See Figures 9-10).

### ***Response to Arguments***

18. Applicant's arguments with respect to claims 1-6 have been considered but are moot in view of the new ground(s) of rejection. Applicant's amendment necessitated the new grounds of rejection.

### ***Conclusion***

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent No. 6,875,304 to Schanke et al., U.S. Patent No. 7,231,952 to Schanke et al., U.S. Patent No. 7,178,572 to Schanke et al., U.S. Patent No. 4,770,729 to Spencer et al., U.S. Patent No. 6,103,051 to Bussey et al., U.S. Patent No. 5,863,383 to Bussey et al. disclose similar labeling devices.



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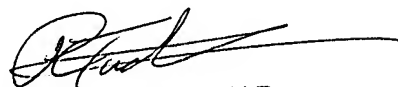
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly K. McClelland whose telephone number is (571) 272-2372. The examiner can normally be reached on 8:00 a.m.-5 p.m. Mon-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Philip C. Tucker can be reached on (571)272-1095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



KKM



PHILIP C. TUCKER, PH.D.  
SUPERVISORY PATENT EXAMINER  
ART UNIT 1791